UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,238	11/28/2001	Gerry Kovan	CA920000055US1	9662

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/995,238	KOVAN ET AL.
	Examiner	Art Unit	
	Thu V Huynh	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 April 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-57</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-57</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 November 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed 01/21/2005 to application

filed on 11/28/2001, which has the benefit of foreign application filed on 11/30/2000.

2.   Claims 1-57 are pending in the case. Claims 1, 16, 26, 41, and 53 are independent claims.

3.   The rejections in previous office action have been withdrawn in view of the amendment.

Claim Objections

4.   Claims 45 is objected to because of the following informalities:

Regarding dependent claim 45, which is dependent on claim 41, the use of "wherein said

document <u>is comprises</u> a notebook" has typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

6.   Claims 47-49 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 47 recites the limitation "the software product as claimed in <u>claim 46, wherein said</u>

<u>plurality of records **created**</u> comprise a plurality of ..." renders the claim is vague and indefinite,

since claim 46 has the limitation of a software product comprising a <u>module **for** creating a</u>

<u>plurality of records,</u> this limitation does not mean that the records are actually created. Such

limitation only means that a software product comprising a <u>module **configures to** create a</u>

plurality of records. Therefore claim 47 fails to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

Dependent claims 48-49 are rejected for fully incorporating the dependencies of their base.

Claim 54 recites the limitation "the product of claim 45, wherein said medium is a

recordable data storage medium". There is insufficient antecedent basis for this limitation in the

claim, since claim 45 does not mention a medium. Although, claim 53 mentions a medium,

however, claim 54 cannot dependent on claim 53, since recorded data storage is not a type of is

signal-bearing medium. Therefore, claim 54 fails to particularly point out and distinctly claim

the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

8.   Claims 26-57 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Regarding claims 41-51, the software product and/or computer program is/are not tangibly

embodied on a computer, computer readable medium or other statutory device.

Regarding claims 26-40, 52-57. These claims limitations are not limited to tangible

embodiments. In view of Applicant's disclosure, specification page 5, lines 9-11, the medium is

not limited to tangible embodiments, instead being defined as including both tangible

embodiments (e.g., storage) and intangible embodiments (e.g., transmitted as a signal, such as on

a modulated carrier signal, network, internet). As such, the claim is not limited to statutory

subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who
has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

10.   **Claims 1, 3-5, 7-11, 13-16, 19-22, 24-26, 28-30, 32-36, 38-41, 43, 45-47, 49-57 are**

rejected under 35 U.S.C. 102(e) as anticipated by Getchius et al., US 6496,843 B1, filed

03/1999.

Regarding independent claim 1, Getchius teaches the steps of:

-       storing a first plurality of values in at least one first object, said first plurality of

        values comprising initial values of a plurality of data fields in a document (Getchius,

        col.5, lines 15-36; col.10, lines 14-40; col.39, lines 1-10; col.44, lines 35-53; and

corresponding figures; user enters business information in online form (fig.22) and storing entered values of fields an existing database and existing database copy);

- storing a second plurality of values in at least one second object, said second plurality of values being identical to said first plurality of values (Getchius, col.44, lines 35-53; storing values of fields in an updated database copy);

- receiving modifications from a user to said data fields and storing said modifications in said at least one second object as current values (Getchius, col.10, lines 33-41; col.44, lines 35-53; and corresponding figures; changing values of the data fields and storing said changed values as current values on an updated database copy);

- comparing said first and second plurality of values to determine which data fields have initial values different from their current values (Getchius, col.44, lines 8-53; comparing the values in existing database and updated database copy to determine the different between two data sets);

- creating a plurality of records identifying all data fields having initial values different from their current values as determined in step comparing (Getchius, col.44, lines 8-53; comparing to produce the <u>delta or different</u> of records and classifying the delta records as insert, delete, or update operation, wherein the delta of records having identifiers in both sets, but having associated strings differ are considered update records. For example, when update an address of a business record, the update data (new address), which is different from data (old address) in the existing database is produced in order to update/modify the existing database); and

-      transmitting said plurality of records to a server, said plurality of records for use in

updating data in a data storage device (Getchius, col.13, lines 11-15; col.39, lines 29-

32; only changes or updates to particular entries are transmitted to Front End Server

from the Backoffice for updating the database stored in the Front End Server instead

of updating or overwriting the entire copy of the database).

Regarding dependent claim 3, which is dependent on claim 2, Getchius teaches wherein

step storing a first plurality of values is performed when said HTML form is loaded into a web

browser (Getchius, col.5, lines 15-36; col.10, lines 14-40; col.39, lines 1-10; col.44, lines 35-53;

col.15, line 45 – col.16, line 3; HTML form must be loaded into a web browser for the user

enters business information in online form (fig.22) and storing entered values of fields an

existing database and existing database copy).

Regarding dependent claim 4, which is dependent on claim 3, Getchius teaches wherein

the step comparing is performed after said modifications have been completed by said user

(Getchius, col.10, lines 33-41 and col.44, lines 8-53).

Regarding dependent claim 5, which is dependent on claim 4, Getchius teaches wherein

said plurality of records comprise a plurality of data field identifiers, and wherein each of said

data field identifiers identifies one of said plurality of data fields in said document (Getchius,

col.44, lines 8-53; figure 26).

Regarding dependent claim 7, which is dependent on claim 1, Getchius teaches wherein said document comprise a notebook (Getchius, col.5, lines 15-37 and fig.3).

Regarding dependent claim 8, which is dependent on claim 7, Getchius teaches wherein said notebook comprises at least one panel (Getchius, col.5, lines 15-37 and fig.3).

Regarding dependent claim 9, which is dependent on claim 8, Getchius teaches wherein step storing a first plurality of values is performed when said notebook is opened (Getchius, col.5, lines 15-36; col.10, lines 14-40; col.39, lines 1-10; col.44, lines 35-53; col.15, line 45 – col.16, line 3; HTML form must be loaded into a web browser for the user enters business information in online form (fig.22) and storing entered values of fields an existing database and/or existing database copy when the user presses the "submit information" button (fig.22)).

Regarding dependent claim 10, which is dependent on claim 9, Getchius teaches wherein step comparison is performed on data in a panel of said at least one panel after said modifications have been completed by said user (Getchius, col.10, lines 33-41 and col.44, lines 8-53).

Regarding dependent claim 11, which is dependent on claim 10, Getchius teaches wherein step creating is performed for said panel of said at least one panel, wherein said plurality of records created comprise a plurality of data field identifiers, and wherein each of said data field identifiers one of said plurality of data fields in said panel (Getchius, col.44, lines 8-53).

Regarding dependent claim 13, which is dependent on claim 12, Getchius teaches wherein step comparing, creating and transmitting are repeated for each panel in a notebook (Getchius, col.5, lines 15-36; col.10, lines 14-40; col.39, lines 1-10; col.44, lines 35-53; col.15, line 45 – col.16, line 3; and col.56, lines 19 – col.57, line 5; to update information whenever a user requests/submits changed information, the step of comparing, creating and transmitting are repeated for the panel in the notebook, wherein the notebook has at least one panel).

Regarding dependent claim 14, which is dependent on claim 13, Getchius teaches wherein said plurality of records are used to determine at least one of the following whether a data field has an initial value different from its current value; whether a panel comprises a data field having an initial value different from its current value; whether said notebook comprises a panel which comprises a data field having an initial value different from it current value (Getchius, col.44, lines 8-53).

Regarding dependent claim 15, which is dependent on claim 1, Getchius teaches wherein said document comprises a hierarchy of documents, and wherein said plurality of records are used to determine whether a data field having an initial value different from its current value exists at a specified level of said hierarchy of documents (Getchius, figure 7; col.15, line 45 – col.16, line 3; col.44, lines 8-34 and col.56, lines 19 – col.57, line 5).

Claims 16, 18-25 for a system of presenting the method of claims 1, 5-8, 11-12, 14-15,

respectively, and are similarly rejected under the same rationale.

Claims 26, 28-40 are for a computer readable medium presenting the method of claims 1, 3-15, respectively, and are similarly rejected under the same rationale.

Claims 41, 43-50 are for a software product performing the method of claims 1, 5-8, 11-12, 14-15, respectively, and are similarly rejected under the same rationale.

Claims 51-52 are for a computer program performing the method of claim 1, and are rejected under the same rationale.

Claims 53-57 are for a computer program product performing the method of claim 1, and are rejected under the same rationale. Getchius teaches computer program product for displaying data in a database comprising machine executable code (Getchius, claim 29) to perform the method of claim 1 as explained above. Getchiu teaches a system for performing online data queries is a distributed computer system, wherein a update techniques are used to updated a plurality of server nodes (Getchiu, abstract). Therefore, the limitation of " a recordable data storage medium", such as a hard drive of the computer, must be inherently included to perform the updating information that is provide from a user (client) through online form to a server. It is noted that claim 53-57 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
owned at the time a later invention was made in order for the examiner to consider the applicability of 35
U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12.   **Claims 6, 17, 27, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over <u>Getchius</u> et al., US 6496,843 B1, filed 03/1999.

Regarding dependent claim 2, which is dependent on claim 1, Getchius teaches wherein

said document is an PHTML document containing an HTML form (Getchius, col.15, line 45 –

col.16, line 3).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Getchius' PHTML document to include an HTML

document, since PHTML files are HTML instructions with embedded processing instructions.

Claim 17 is for a system of presenting the method of claim 2 and is similarly rejected

under the same rationale.

Claim 27 is for a computer readable medium presenting the method of claim 2 and is

similarly rejected under the same rationale.

Claim 42 is for a software product presenting the method of claim 2 and is similarly rejected under the same rationale.

13.   **Claims 6, 12, 18, 23, 31, 37, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Getchius</u>, and further in view of <u>Baillargeon</u> et al., US 2002/0046076 A1, priority filed 09/2000.**

Regarding dependent claim 6, which is dependent on claim 5, Getchius does not explicitly disclose a Boolean value assigned to each of said data field identifiers to indicate whether said data field has an initial value different from it current value as determined in step comparison.

Baillargeon teaches a Boolean value assigned to each of said data field identifiers to indicate whether said data field has updated (Baillargeon, page 4, paragraphs 50-52, fig.2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Baillargeon's using Boolean into Getchius to mark data field identifiers that need to be update, since this would have facilitate the updating of values of the data fields that need to be changed and keep track what data is updated or need to be update.

Regarding dependent claim 12, which is dependent on claim 11, Getchius does not explicitly disclose wherein said plurality of records further comprise a Boolean value assigned to each of said data field identifier to indicate whether said data field has an initial different from its current value as determined in step comparing.

Baillargeon teaches a Boolean value assigned to each of said data field identifiers to

indicate whether said data field has updated (Baillargeon, page 4, paragraphs 50-52, fig.2).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Baillargeon's using Boolean into Getchius to mark data

field identifiers that need to be update, since this would have facilitated the updating of values of

the data fields that need to be changed and keep track what data is updated or need to be update.

Claims 18 and 23 are for a system of presenting the method of claims 6 and 12

respectively, and are similarly rejected under the same rationale.

Claims 31 and 37 are for a computer readable medium presenting the method of claims 6

and 12, respectively, and are similarly rejected under the same rationale.

Claims 44 and 48 are for a software product performing the method of claims 6 and 12,

respectively, and are similarly rejected under the same rationale.

Response to Arguments

6.   Applicant's arguments filed 01/21/2005 have been fully considered but they are not

persuasive.

Applicants argue with respect to claim 1 that Getchius does not disclose the step of

"creating a plurality of records *identifying* all data fields having initial values different from their

current values" (emphasis by applicants) as claimed.

This is not persuasive. Getchius teaches after comparing the new records in update

database with existing records in existing database in backoffice. The delta or differences of

records are produced and classified (Getchius, col.44, lines 8-34). Getchius teaches that each

entry in the differences is classified as insert, delete, or update operation (Getchius, col.44, lines 20-22). It is clearly that in order to classify, each produced (the delta) record must be identified as Getchius disclosed "[r]ecords in which identifiers are both sets, but, however have associated strings that differ are considered update records having data contents in the string that is updated for the corresponding identifiers".

Applicants argue that examiner failed to state a proper motivation to combine the references and Baure is non-analogous art.

This is not persuasive. However, Getchius teaches all limitiation of claim 1 as explained in the rejection above.

Applicants argue with respect to claim 1 that Moore does not disclose plurality of records comprise a Boolean value assigned to each of said data field identifiers.

Examiner agrees. However, Baillargeon teaches such limitation as explained in the rejection above.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Midgley et al., US 6,625,623 B1, filed 12/1999, teaches system and method for backing up data files.
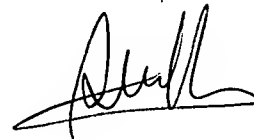
Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The

examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
April 28, 2005

**STEPHEN HONG
SUPERVISORY PATENT EXAMINER**